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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Elegant Headwear Co., Inc.

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Serial No. 75886511

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Myron Amer for Elegant Headwear Co., Inc.

Mary Rossman, Trademark Examining Attorney, Law Office 108 (David Shallant, Managing Attorney).

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Before Seeherman, Quinn and Holtzman, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application has been filed by Elegant Headwear Co., Inc. to register the mark MAGIC STRETCH GLOVES ("GLOVES" disclaimed) for goods identified in the application (as amended) as "children's gloves, namely, in the nature of one size fits all consisting of 95% acrylic spandex."[1]

The Trademark Examining Attorney has refused

[1] Application Serial No. 75886511, filed January 5, 2000, based on an allegation of a bona fide intention to use the mark in commerce.

registration under Section 2(d) on the ground that applicant's mark, if applied to applicant's goods, would so resemble the previously registered mark MAGIC GLOVE ("GLOVE" disclaimed) for "fashion gloves for youth"[2] as to be likely to cause confusion. In addition, the Examining Attorney made final the following requirements: (i) to disclaim the words "Stretch Gloves" apart from the mark; and (ii) to submit advertising and/or promotional materials for applicant's goods that make clear the nature of the goods.

When the refusal and requirements were made final, applicant appealed. Applicant and the Examining Attorney have filed briefs.[3] An oral hearing was not requested.

Requirement for Promotional Materials

In the Office action dated September 27, 2002, the

[2] Registration No. 2,090,700, issued August 26, 1997; combined Sections 8 and 15 affidavit filed.

[3] There are two evidentiary matters that require our attention. The first concerns applicant's submission, for the first time with its brief, of certain evidence. The Examining Attorney has objected to the evidence as untimely. In view of the untimely submission, the evidence has not been considered. Trademark Rule 2.142(d). Even if considered, however, the evidence would not be persuasive of a different result in this case.

The second matter concerns applicant's objection made in its brief to certain evidence attached to the final refusal. Contrary to applicant's contention, the submission is timely. Further, applicant had an opportunity to respond thereto with contravening evidence and arguments by way of a request for reconsideration. In point of fact, applicant did file a request for reconsideration, but apparently chose not to submt evidence in response to the Examining Attorney's evidence.

Examining Attorney required applicant to submit samples of advertisements or promotional materials because, in the Examining Attorney's view, "the nature of the goods in connection with which the applicant intends to use the mark is not clear from the present record." In response, applicant submitted a hanging point-of-sale display to which applicant's gloves are attached.[4] The point-of-sale hang tag indicates that applicant's goods are "stretch gloves," that the gloves are "stretched to all sizes for a super fit," and that "one size fits all." The hang tag also states that the gloves are manufactured from acrylic and spandex. Applicant also amended the identification of goods (from "children's gloves" to "children's gloves, namely, in the nature of one size fits all consisting of 95% acrylic spandex") in order "to correct [any] ambiguity" about the goods. The Examining Attorney noted the hang tag display, and accepted the amended identification, but indicated that there still was a failure to submit "advertisements or promotional materials for the goods that make clear the nature of the goods, their salient features, and the prospective customers and/or channels of trade."

[4] Although the application is based on an intent to use the mark, and applicant has not submitted an amendment to allege use, it appears that applicant has, in fact, commenced use of the mark.

The Examining Attorney also indicated that she was unable to locate any such information about the goods on the Internet.

Trademark Rule 2.61(b) provides that the "examiner may require the applicant to furnish such information and exhibits as may be reasonably necessary to the proper examination of the application." More specifically, the "examining attorney may request literature, exhibits, and general information concerning circumstances surrounding the mark and, if applicable, its use or intended use." TMEP § 814 (3rd ed. 2003).

Although the Examining Attorney's request originally was legitimate, we find that the amended identification of goods to more specifically set forth the nature of the goods, coupled with the hanging display bearing information about the goods, were sufficiently responsive to the Examining Attorney's requirement. Applicant's gloves are ordinary consumer items, and the information available to the Examining Attorney was sufficient to allow the proper examination of the application.

Accordingly, the requirement for additional materials is reversed.

Disclaimer Requirement

Although applicant has disclaimed the word "Gloves" apart from the mark, the Examining Attorney has made final the requirement to disclaim the words "Stretch Gloves." Applicant asserts as follows:

> It is the applicant's argument that the STRETCH is MAGIC, and that is why "one size fits all." The two words MAGIC STRETCH are a unitary two-word component, and not separable unrelated words. If STRETCH is used solely to describe a characteristic of the word GLOVE, it should be spelled STRETCHABLE.

As best we understand applicant's contention, it is that "MAGIC STRETCH" is unitary, as opposed to "STRETCH GLOVES," and that, therefore, a disclaimer of the latter is improper.

The Examining Attorney maintains that there is nothing unitary about "MAGIC STRETCH," that the goods are "stretch gloves," and that, consequently, the required disclaimer is proper. In support of this requirement, the Examining Attorney submitted excerpts retrieved from the NEXIS database and from the Internet showing generic usage in the trade of the term "stretch gloves." Also of record are third-party registrations showing disclaimers of the term "Stretch" in marks for various items of clothing. The

Examining Attorney also furnished a dictionary definition of the term "stretch" which, in pertinent part, is an adjective meaning "easily stretched." Merriam-Webster's Collegiate Dictionary (1996).[5]

TMEP § 1213.05 (3rd ed. 2003) provides as follows:

> A mark or a portion of a mark is considered "unitary" when it creates a commercial impression separate and apart from any unregistrable component. That is, the elements are so merged together that they cannot be divided to be regarded as separable elements. If the matter that comprises the mark or relevant portion of the mark is unitary, no disclaimer of an element, whether descriptive, generic or otherwise, is required.
>
> For example, a descriptive word can be combined with nondescriptive wording in such a way that the descriptive significance of the word in relation to the goods is lost and the combination functions as a unit. This happens when the combination itself has a new meaning. An example is the term "Black Magic," which has a distinct meaning of its own as a whole. The word "black" is not intended to have color significance in relation to the goods, and should not be disclaimed even if the mark is applied to goods that are black in color.

In the present case, there is no readily understood meaning of "Magic Stretch." Rather, the record clearly

[5] The dictionary definition, of which we take judicial notice, appears in the Examining Attorney's brief.

establishes that the term "stretch gloves" is a common generic name for the type of gloves intended to be sold by applicant. The term "stretch glove" is a unitary generic name and it must be disclaimed apart from the mark as shown in the typed drawing. See: Dena Corp. v. Belvedere International Inc., 950 F.2d 1555, 21 USPQ2d 1047 (Fed. Cir. 1991); and In re Lean Line, Inc., 229 USPQ 781 (TTAB 1986). The stylized display of applicant's mark on the hang tag does not compel a different result on this issue.

Accordingly, the requirement of a disclaimer of the words "Stretch Gloves" is affirmed.

Likelihood of Confusion

Registration has been refused under Section 2(d) of the Trademark Act on the ground that applicant's mark, if applied to applicant's identified goods, would so resemble the previously registered mark MAGIC GLOVE for "fashion gloves for youths" as to be likely to cause confusion.

Applicant essentially contends that its "children's gloves, namely, in the nature of one size fits all consisting of 95% acrylic spandex" are "radically different" from the "fashion gloves for youths" listed in the cited registration. Applicant argues that this difference, coupled with differences between the marks, avoids the likelihood of confusion.

The Examining Attorney asserts that the marks and goods are similar so that there is a likelihood of confusion. Of record are definitions of the terms "child," "youth," and "fashion/fashionable."

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also: In re Majestic Distilling Company, Inc., 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also: In re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

With respect to the goods, it is well established that the goods of the parties need not be similar or competitive, or even that they move in the same channels of trade, to support a holding of likelihood of confusion. It is sufficient that the respective goods are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods are such that they

would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same source. See In re International Telephone & Telephone Corp., 197 USPQ 910, 911 (TTAB 1978).

The goods herein are closely related. Both the cited registration and the involved application list gloves to be worn by individuals young in age. The differences pointed to by applicant are simply irrelevant in our likelihood of confusion analysis. The respective gloves would be purchased by the same classes of purchasers and would travel in the same or similar channels of trade. Further, the Examining Attorney's evidence shows that gloves of the types involved herein can be relatively inexpensive and, therefore, may be purchased on impulse. As a result, consumers are not likely to notice minor differences in the marks for such goods.

As to the marks, the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains

a general rather than a specific impression of trademarks. See: Sealed Air Corp. v. Scott Paper Co., 190 USPQ 106 (TTAB 1975). Further, although the marks at issue must be considered in their entireties, it is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See: In re National Data Corp., 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

The marks MAGIC GLOVE and MAGIC STRETCH GLOVES are quite similar when viewed in their entireties in terms of sound, appearance and meaning. Indeed, the marks are identical but for the presence of the descriptive word STRETCH as the second word in applicant's mark. Both marks begin with the word MAGIC and end with the word GLOVE(S). The dominant feature in both marks is the first word MAGIC, which appears to be arbitrary or at most only suggestive as applied to gloves. The strength of the term MAGIC in the cited mark is further shown by the absence of any evidence of third-party use or registrations of MAGIC or similar marks on gloves. The remaining wording in each mark, that is, GLOVE(S) and STRETCH GLOVES, respectively, is descriptive/generic matter. Any dissimilarity between the marks which results from the presence of the work STRETCH

in applicant's mark and the absence of that word from registrant's mark is greatly outweighed by the similarity which results from the fact that both marks start with the word MAGIC and end with the word GLOVE(S). Moreover, as shown by the record, STRETCH merely identifies a type of glove.

In view of the above, consumers are likely to believe that applicant's MAGIC STRETCH GLOVES identifies a stretch version of registrant's gloves sold under the mark MAGIC GLOVE. In sum, we find that there is a likelihood of confusion.

Decision

The refusal to register based on likelihood of confusion is affirmed.

The requirement for a disclaimer of the words "Stretch Gloves" is affirmed. In the event that applicant submits a disclaimer of the words "Stretch Gloves" apart from the mark within thirty days of the mailing date of this decision, this portion of the decision will be set aside.

The requirement for additional information is reversed.